

REMARKS/ARGUMENTS

Status of the Claims

Claims 1-49 were previously pending. Claims 1 and 3 to 8 are currently amended. Claims 9 to 49 are canceled without prejudice. Claims 50 to 52 are newly presented. After entry of these amendments, Claims 1 to 8 and 50 to 52 will be pending.

Response to the Restriction Requirement

Claims 1-49 were subject to a Restriction Requirement. Applicants would elect the subject matter of treating obesity. Without acquiescing to the position of the Examiner, the Applicants have canceled claims to the nonelected subject matter in order to facilitate examination of the Application.

Applicants further elect the compound of claim 3 as the compound species to be examined.

Support for the Amendments to the Claims

Claim 1 was amended to set forth "treating obesity" in place of "modulating Type 2 diabetes." Support for this subject matter is found *inter alia* in the specification at p. 24, line 22. Claim 1 was further amended to set forth that each X is independently a halogen. Support for this subject matter is found in *inter alia* in original dependent claim 3 in which the "X's" are not all the same halogen. Obesity is defined in the specification at p. 15, 2nd full paragraph.

Claim 1 was further amended to recite "a composition comprising the (-) enantiomer" and to recite "wherein the composition contains the (-) enantiomer of the compound in an enantiomeric excess of at least 90% relative to the (+) enantiomer of the compound, and wherein the composition exhibits a reduced inhibition of cytochrome P450 2C9 relative to a composition having an enantiomeric excess of the compound of about 0%." Support for the "90%" subject matter is found in the specification at p. 21, first full paragraph. Support for the "reduced inhibition of cytochrome P450 2C9" subject matter is found in the specification at p. 19, first two full paragraphs.

Dependent claims 3 to 8 were accordingly amended to reflect the changes in the antecedent afforded by the amended base claim.

New claim 50 depends from claim 1 and recites "wherein the (-) enantiomer is (-) 4-chlorophenyl-(3-trifluoromethylphenoxy) acetic acid." Support for this subject matter is found in the specification at p. 35, Example 3.

New claim 51 depends from claim 1 and recites "wherein the enantiomeric excess is at least 98%." Support for this subject matter is found in the specification at p. 21, last full paragraph as well as in the following paragraph.

New claim 52 depends from claim 1 and recites "wherein the composition consists essentially of the (-) enantiomer of the compound of Formula I." Support for this subject matter is found *inter alia* in original claim 1, at p. 22, first full paragraph, and at p. 22, line 9.

In view of the above, the Applicants believe the Amendments to the claims add no new matter and respectfully request their entry.

Remarks Concerning the Information Disclosure Statement

Applicants call the Examiner's attention to each of the following related U.S. Patents and co-pending related patent applications:

U.S. Patent No. 6,646,004 "Use of (-) (3-trihalomethylphenoxy) (4-halophenyl) acetic acid derivatives for treatment of insulin resistance, type 2 diabetes and hyperlipidemia." The '004 patent issued with claims drawn in part to the subject matter of methods for modulating insulin resistance.

U.S. Patent No. 6,624,194 "Use of (-) (3-trihalomethylphenoxy) (4-halophenyl) acetic acid derivatives for treatment of insulin resistance, type 2 diabetes, hyperlipidemia and hyperuricemia." The 6,624,194 patent issued with claims drawn in part to the subject matter of methods for modulating type II diabetes.

U.S. Patent No. 6,613,802 "Use of (-) (3-trihalomethylphenoxy) (4-halophenyl) acetic acid derivatives for treatment of insulin resistance, type 2 diabetes, hyperlipidemia and hyperuricemia." The '802 patent issued with claims drawn in part to the subject matter of treating hyperuricemia.

U.S. Patent No. 6,262,118 "Use of (-) (3-trihalomethylphenoxy) (4-halophenyl) acetic acid derivatives for treatment of insulin resistance, type 2 diabetes and hyperlipidemia. In particular, the '118 patent issued with claims, among others, drawn in part to methods of treating Type II diabetes."

U.S. Patent Application No. 10/432742, filed on May 27, 2003, for Use of (-) (3-Halomethylphenoxy) (4-Halophenyl) Acetic Acid Derivatives for Treatment of Insulin Resistance, Type 2 Diabetes, ... This case is a continuation in part of the patent application which issued as U.S. Patent No. 6,624,194 and is currently with Examiner Pryor. It presently presents claims drawn to methods of treating type II diabetes and/or insulin resistance.

U.S. Patent Application No. 10/382,186 filed on March 04, 2003 for Use of (-) (3-Trihalomethylphenoxy) (4-Halophenyl) Acetic Acid Derivatives for Treatment of Insulin Resistance, This case is assigned, as is the instant application, to Examiner Cook and has recently been amended to more particularly focus that application on subject matter pertaining to "Syndrome X".

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for Examination.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 925-472-5000.

Respectfully submitted,



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